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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIM SIMELIUS and PETRI LEHTOVIRTA

Appeal 2009-005095
Application 10/645,687¹
Technology Center 2100

Before JAY P. LUCAS, ST. JOHN COURTENAY III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed August 20, 2003. The real party in interest is Nokia Corp. (App. Br. 3.)

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal from the Examiner's rejection of claims 1-22 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' Invention

The invention at issue on appeal relates to a method and apparatus for transmitting or transferring data and synchronizing data between a user's mobile terminal and another electronic device. When a user stores data (a data item) to the memory of the user terminal, the user may associate the item with a grouping identifier that further associates the data item to a specific group of data items and then synchronizes the data item between the terminal and another electronic device utilizing the grouping identifier. (Spec. 1, ll. 3-5, 9-13; 2, ll. 21-32; 3, ll. 4-14.)³

Representative Claim

Independent claim 1 further illustrates the invention. It read as follows:

1. A method comprising:
forming a data item for the first time in a first electronic device,
in response to said forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item;

³ We refer to Appellants' Specification ("Spec."); Appeal Brief ("App. Br.") filed May 5, 2008; and Reply Brief ("Reply Br.") filed September 22, 2008. We also refer to the Examiner's Answer ("Ans.") mailed July 21, 2008.

in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item with said existing grouping identifier, said existing grouping identifier being associable with at least one other data item,

in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier,

selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier, and

synchronizing said data item between said first electronic device and a second electronic device on the basis of said selected grouping identifier, said devices being capable of communication with each other.

References

The Examiner relies on the following references as evidence of unpatentability:

Hunkins	US 6,141,663	Oct. 31, 2000
Alam	US 6,324,544 B1	Nov. 27, 2001
Champagne	US 2005/0086199 A1	Apr. 21, 2005
(Cont. of US Application No. 09/052,769 filed Mar. 31, 1998)		

*Rejections on Appeal*⁴

The Examiner rejects claims 1-8, 12-20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Alam and Champagne.

The Examiner rejects claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Alam, Champagne, and Hunkins.

ISSUE

Based on our review of the administrative record, Appellants' contentions, and the Examiner's findings and conclusions, the pivotal issue before us is as follows:

Does the Examiner err in finding the Alam and Champagne references would have collectively taught or suggested "providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item . . . [and responsively] obtaining a new grouping identifier and associating the formed data item with the new grouping identifier," as recited in claim 1?

⁴ The Examiner withdraws the rejection to claims 1-22 under 35 U.S.C. § 102(b) as being anticipated by Celik (US Patent Pub. No. 2004/0236792) (Ans. 3). We do not address Appellants' arguments directed to the withdrawn rejection.

FINDINGS OF FACT (FF)

Alam and Champagne References

We adopt as our own the Examiner's findings with respect to the Alam and Champagne references set out in the Answer. (Ans. 4-6, 16-18.)

ANALYSIS

We select independent claim 1 as representative of Appellant's groupings and arguments with respect to the Examiner's obviousness rejection of claims 1-8, 12-20, and 22, and we will address Appellants' arguments with respect thereto. 37 C.F.R. § 41.37 (c)(1)(vii). *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). The Examiner sets forth a detailed explanation of a reasoned conclusion of obviousness in the Examiner's Answer with respect to representative claim 1. (Ans. 4-6, 16-18.) Therefore, we look to the Appellants' Briefs to show error in the proffered reasoned conclusions. *See Kahn*, 441 F.3d at 985-86.

Arguments Concerning the Examiner's Rejection of Claims 1-8, 12-20, and 22 under 35 U.S.C. § 103

The Examiner rejects representative claim 1 for being obvious in view of the combination of the Alam and Champagne references. (Ans. 4-6, 16-18.) Appellants contend, *inter alia*, that Alam and Champagne do not teach obtaining a new grouping identifier and associating the formed data item with the new grouping identifier (App. Br. 17-20), i.e., the user obtaining

(creating) a new grouping identifier and associating (linking) the data item to the new identifier. The Examiner finds that Alam and Champagne teach the disputed features. (Ans. 4-6, 16-18.)

Specifically, the Examiner finds that “Alam teaches . . . forming a data item for the first time into the first electronic device” (Ans. 4), but “Alam does not explicitly teach[] . . . in response to said forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item” (Ans. 4) or “obtaining a new grouping identifier and associating the formed data item with the new grouping identifier” (Ans. 5).

The Examiner finds Champagne teaches these features, citing paragraphs 11 and 36 of Champagne (Ans. 5). The Examiner also finds, in response to Appellants’ arguments, that Alam teaches associating an existing grouping identifier and the formed data item into a “tailored grouping of data items” (Ans. 16; see Ans. 16-17 – discussing Personal Information Manager (PIM) programs), and the combination of Alam and Champagne teaches obtaining a “new grouping item” and associating “a formed data item within the new grouping item” (Ans. 18, citing Alam, col. 10, ll. 10-67).

Based on the record before us, we find error in the Examiner’s obviousness rejection of representative claim 1. We agree with Appellants that the Alam and Champagne references do not teach or suggest the disputed features of a user obtaining a new grouping identifier and associating the formed data item with the new grouping identifier for essentially the reasons espoused by Appellants.

The Examiner concedes that Alam does not teach providing a user of with the capability of associating an existing grouping identifier with the formed data item (*supra*, Ans. 4), nor the user obtaining a new grouping identifier and associating the data item with the new identifier (*supra*, Ans. 5). The Examiner relies on Champagne to cure these deficiencies, finding that Champagne describes lists of “field categories (identifiers) for grouping of data items” and “*information identify[ing] both the categories and the properties of a plurality of fields of the record structure.*” (Ans. 5).

The cited sections of Champagne (¶¶ [0011] and [0036]), however, do not describe any user interaction, nor do they describe obtaining a new identifier. Instead these sections of Champagne describe automated synchronization between databases, and equivalent categories. We do not find these sections of Champagne describe a user obtaining a new grouping identifier and associating the data item with the new identifier.

The Examiner provides an additional citations to Alam (col. 10, ll. 10-67), which discusses Application Programming Interfaces (APIs) (specifically handler interfaces that manipulate object handles (names)), as well as Champagne (¶¶ [0017], [0018], [0020], [0036], [0040], [0042], [0050]-[0056], and [0060]) – without additional explanation. (Ans. 18.) We do not find either the cited portion of Alam, or the cited portions of Champagne to describe a user obtaining a new grouping identifier and associating the data item with the new identifier.

Rather, Alam describes automated processes, APIs, which manipulate object names, but do not describe any user interaction, much less a user creating or obtaining a new group identifier and associating an item with the new identifier. The Examiner fails to provide any explanation of the cited

portions of Champagne, and we find the cited portions of Champagne describe mapping categories between databases, but do not describe user interaction, much less a user creating or obtaining a new group identifier and associating an item with the new identifier. Consequently, we agree with Appellants that Alam and Champagne do not teach a user obtaining a new group identifier and associating an item with the new identifier as recited in claim 1.

We, therefore, are constrained by the record before us to find that the Alam and Champagne references would not have collectively taught or suggested at least the disputed feature of “providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item . . . [and responsively] obtaining a new grouping identifier and associating the formed data item with the new grouping identifier” as recited in claim 1. The Examiner has failed to set forth a *prima facie* obviousness rejection. It follows that Appellants have persuaded us to find error in the Examiner’s obviousness rejection of representative independent claim 1.

Independent claims 15 and 22 include limitations commensurate in scope to the disputed limitations of claim 1. Dependent claims 2-14 (dependent on claim 1) and 16-21 (dependent on claim 15) depend on their respective base independent claims. For the reasons set forth with respect to claim 1 (*supra*), we find that the combination of the Alam and Champagne falls short of teaching or suggesting at least one feature of claims 2-22. The addition of the Hunkins reference, cited by the Examiner with respect to claims 9-11 and 21 (Ans. 14-16), does not cure these noted deficiencies. Consequently, we are constrained by the record before us to find that the

Examiner's cited prior art combinations of Alam and Champagne, and Alam and Champagne with Hunkins would not have collectively taught or suggested the disputed limitations of claims 2-22. It follows that Appellants have also persuaded us to find error in the Examiner's obviousness rejection of claims 2-22. Accordingly, we reverse the Examiner's obviousness rejection with respect to claims 1-22.

CONCLUSIONS OF LAW

Appellant has shown that the Examiner erred in rejecting claims 1-22 under 35 U.S.C. § 103(a).

DECISION

We reverse the Examiner's rejection of claims 1-22 under 35 U.S.C. § 103(a).

REVERSED

llw

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